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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,651	09/19/2003	Brendan T. McSheffrey	16246-004001	4621
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FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER LEIVA, FRANK M	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 06/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/664,651

Applicant(s)

MCSHEFFREY ET AL.

Examiner

Frank M. Leiva

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Richard's Play-By-eMail Server herein after known as Richard's PBeM.**

3. **Regarding claim 1, 16, 31, 46, and 50;** Richard's PBeM discloses a server implemented to allow users to play games via the e-mail system, discloses the receiving of e-mail games, storing the plurality of e-mail games on the server, providing access to the games for retrieval, sending the e-mail games to players who wish to play, (Page 2:1-15).

4. **Regarding claim 2, 17, 32, 47, and 51;** Richard's PBeM discloses receiving a file from the first player presenting the first player move associated with an instance of the game, producing an e-mail message that includes data representing the first game move (commands), and transmitting the e-mail message to all players to initiate a second move by the appropriate player. (Page 2:1-15).

5. **Regarding claims 7-10, 22-25, and 37-40;** Richard's PBeM discloses messages sent from one player to another as taunts, where the file identifies the second player by assigning ids to players and including them in every message, storing the first game move by keeping a historical record of all games, and an invitation to the second player to participate by creating the second move, (Page 1 and 2).

6. **Regarding claims 12-14, 27-29, and 42-44;** Richard's PBeM discloses e-mails with updated information as to the state of the game, games such as chess or checkers that require players to take turns and that each players moves are dependant on receipt of the other's e-mail message, (Pages 1 and 2).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 3-6, 11-15, 18-21, 26-30, 33-36, 41-45, 48, 49, and 52, are rejected under 35 U.S.C. 103(a) as being unpatentable over Richard's Play-By-eMail Server in view of Official Notice.**

9. **Regarding claims 3-6, 15, 18-21, 30, 33-36, 45, 48, 49, and 52;** Richard's PBeM discloses an E-mail game developer site, with a plurality of game themes to play, (Page 1), a storage device or server to hold all the game history of the multiple e-mail games, (Page 2:1-10), the use of the latest software on the internet. Yet is silent to the use of HTTP and XML because they were not available yet by the time this page was created in 1998. Web pages from 2002 have been updated to HTTP and XML languages including JAVA active-X. The examiner takes Official Notice that in order to use the Internet programmers have to update their systems constantly to the latest bells and whistles that the Internet uses.

10. **Regarding claims 11, 26, and 41;** Richard's PBeM discloses that his server is there for the benefit of the public and accepts only donations, thus it fail to disclose the use of advertisement through out the e-mails. The examiner takes Official Notice to the fact that sending advertisements via e-mails such as an add on or bottom line of a company communication and to sell a list of the subscribers e-mail addresses to marketing companies is a well known in the art tool for creating revenues and it would have been obvious to one of ordinary skill in the art to do so.

### ***Double Patenting***

11. Claims 1-52 are rejected on the ground of nonstatutory double patenting over claims 1-24 of U. S. Patent No. 6,264,562 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: E-Mail games being played over the Internet and with commands being sent via e-mail messages.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Leiva whose telephone number is (571) 272-2460. The examiner can normally be reached on M-Th 8:30am - 5:pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

06/13/2007

  
Robert E Pezzullo  
Supervisory Patent Examiner  
Art Unit 3714